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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,194	04/01/2004	Tetsuji Shono	124986	7937

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EXAMINER	
VILLECCO, JOHN M	

ART UNIT	PAPER NUMBER
2612	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,194	SHONO, TETSUJI	
	Examiner	Art Unit	
	John M. Villecco	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-13* is/are allowed.

6)☒ Claim(s) *14-31* is/are rejected.

7)☒ Claim(s) *15,16,24 and 25* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/089,404.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/13/04, 4/28/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments

1. Applicant has cancelled claims 1-13 of co-pending application 10/815,193, thus obviating the provisional statutory double patenting rejection from the previous office action mailed on December 28, 2004.

2. Additionally, applicant has elected not to file a terminal disclaimer to overcome the non-statutory double patent rejection of claims 14-31 until the currently pending claims have been indicated as being allowable. Therefore, the non-statutory double patenting rejection will be maintained.

3. Applicant's amendment to claims 14 and 23 have overcome the prior art of record. However, the examiner has found additional art that can be applied to the currently pending claims. Please see the new grounds of rejection presented on the following pages. Additionally, applicant has asked for a reference in support of the Official Notice that was taken in the rejection of claims 18, 20, 27, and 29. Accordingly, a new ground of rejection has been presented below incorporating this reference.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-31 of copending Application No. 10/815,193 (hereinafter referred to as the '193 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the apparatus claims of the present application could obviously carry out the method claims of the '193 application. More specifically, a double-patenting rejection is proper between a set of apparatus claims and a set of method claims when the method of the reference claims could obviously be carried out by the apparatus of the present application. In this instance, the method claims presented in the '193 application could obviously be carried out by the apparatus claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 14, 17, 19, 21-23, 26, 28, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakabayashi (U.S. Patent No. 4,768,048).**

8. Regarding ***claim 14***, Wakabayashi discloses a camera having a retractable optical system. As shown in Figures 1-3, Wakabayashi discloses a lens barrel (3), moveable along an optical axis between a plurality of photographing positions including a wide-angle and a telephoto position. When the camera is in the telephoto position, all of the lens groups, including the mains lens (3) and a sub-lens (4) are located along an optical axis. When the camera is in the OFF position, the sub-lens is moved out of the optical axis, as shown in Figure 3. Furthermore, Wakabayashi discloses an embodiment in which the sub-lens (4) and the main lens (3) are located along a common plane perpendicular to the optical axis. As shown in Figure 13 and column 8, line 58 to column 9, line 4, Wakabayashi discloses that once the sub-lens (4) is moved into its retracted position, it is located along a plane with the main lens (3), which is perpendicular to the optical axis. This embodiment is clearly showing the sub-lens (4) in its retracted state, which is akin to the sub-lens being in its retracted state as shown in Figure 3. Figure 3 shows that when the sub-lens is in its retracted state the camera can be placed into an

OFF state in which no photographing can occur (col. 2, lines 47-52). Therefore, Figure 13 is showing a state in which the camera can be placed in the OFF state.

9. As for ***claim 17***, Wakabayashi discloses that the camera includes a plurality of lenses (main lens, 3, and sub-lens, 4) and film (F), which is interpreted to be the image pick-up device.

10. With regard to ***claim 19***, Wakabayashi discloses that the camera includes a plurality of lenses (main lens, 3, and sub-lens, 4) and film (F), which is interpreted to be the image pick-up device.

11. Regarding ***claim 21***, Wakabayashi discloses moving the viewfinder optical system (6) in association with the change in focal length of the picture taking lens system. See column 9, lines 5-31.

12. As for ***claim 22***, Wakabayashi disclose that the plurality of photographic positions comprises a zoom range. More specifically, Wakabayashi discloses a telephoto and wide-angle zoom range.

13. ***Claim 23*** is considered substantively equivalent to claim 14. Please see the discussion of claim 14, previously presented.

14. ***Claim 26*** is considered substantively equivalent to claim 17. Please see the discussion of claim 17, previously presented.

15. ***Claim 28*** is considered substantively equivalent to claim 19. Please see the discussion of claim 19, previously presented.

16. ***Claim 30*** is considered substantively equivalent to claim 21. Please see the discussion of claim 21, previously presented.

17. ***Claim 31*** is considered substantively equivalent to claim 22. Please see the discussion of claim 22 presented above.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. **Claims 18, 20, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi (U.S. Patent No. 4,768,048) in view of Chang (U.S. Patent No. 5,264,939)**.

20. Regarding ***claim 18***, as mentioned above in the discussion of claim 17, Wakabayashi discloses all of the limitations of the parent claim. However, Wakabayashi discloses that the image pickup device is film and not a charge-coupled device as claimed. Chang, on the other hand, discloses that the use of charge-coupled devices has significant advantages over the use of film. As described in column 1, lines 12-31, Change discloses that charge-coupled devices are better than film because they store captured images in electronic form. Electronic storage is much cheaper than film, its color information is permanent and it can be quickly and easy reproduced. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a charge coupled devise instead of film in the camera of Wakabayashi for the above-mentioned reasons.

21. ***Claims 20, 27, and 29*** are considered substantively equivalent to claim 18. Please see the discussion of claim 18 above.

Allowable Subject Matter

22. Claims 15, 16, 24, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, as well as overcoming the double patenting rejection previously presented.

23. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claims 15 and 24***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the image pickup device is moved out of the optical axis.

24. **Claims 1-13 are allowed**.

25. The following is an examiner's statement of reasons for allowance:

Regarding ***claim 1***, the primary reason for allowance is that the prior art does not teach or fairly suggest a digital camera with an image pickup device moveable to and from the optical path, a mechanism for moving the image pickup device, and a lens positioned in front of the image pickup device which is moveable from a photographing position to a retracted position.

As for ***claim 13***, the primary reason for allowance is that the prior art does not teach or fairly suggest a digital camera having a retractable photographic lens having an image pickup device and a mechanism for positioning the image pickup device in the optical path of the

photographic lens when a power switch on the digital camera is turned on and moving the image pickup device out of the optical path when the power switch is turned off.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John M. Villecco
May 22, 2005

WENDY R. GARBER
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